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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,789	02/05/2000	Natarajan Ramachandran	D-1096 CIP	9304

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
**09/498,789**Applicant(s)  
**Ramachandran et al.**Examiner  
**Cuong H. Nguyen**Art Unit  
**3625**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on May 9, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

**DETAILED ACTION**

1. This Office Action is the answer to the communication received on 5/09/2000.
2. Claims 1-35 are pending in this application.

**Drawings**

3. This application has been filed with drawings which are acceptable for examining purposes/.
4. The following rejections are based on the examiner's broadest reasonable interpretation of the claims, In re Pearson, 181 USPQ 641 (CCPA 1974).

***Double Patenting***

5.A rejection based on non-statutory double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a **patent** therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See **Miller v. Eagle Mfg. Co.**, 151 U.S. 186 (1894); In re **Ockert**, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); In re **Vogel**, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Where the claims of an application are not the "same" as those of a first patent, but the grant of a patent with the claims in the application would unjustly extend the rights granted by the first patent, a double patenting rejection under non-statutory grounds is proper.

6. Claims 1-35 have similar claimed limitations over US Pat. 6,023,688 issued on 2/08/2001 to **Ramachandran et al.** (see **Ramachandran et al. '688** for similar submitted drawings and claims 1-36 - that represent similar scope and subject matters of previous invention, and the pending application's claims 1-35). The pending application covers an automated transaction machine that dispenses notes to users and which has an internal note storage area; therefore, it reads on the parent invention that relates to devices and systems for carrying out financial transactions that identifies an authorized user based on a user's appearance and voice.

7. The issued patent and this pending application are cross-read, meaning that "the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa". This decision highlights the importance of explicit findings of motivation in PTO decisions, because such findings cannot be supplemented once the case is on appeal to the courts.

8. A non-statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The timely filing of a terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome a

provisional double patenting rejection based upon 35 U.S.C. 101.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-35 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lipkin (US Pat. 5,592,377), in view of So (US Pat. 4,990,848), in view of Atkins (US Pat. 5,644,727), Batson (US Pat. 5,844,327), and further in view of the Official Notice.

Lipkin suggests a system/apparatus/machine/method comprising means/steps (by operating means):

- A financial transaction machine/(an automated check cashing system)/method including an imaging device (for at least claims 2, 15) (Fig.1, camera 28/customer identification module 36, a check identification and storage module 42), an audio input/output (for at least claims 3, 15, 28) (Fig.1, a

handset 26), and a transaction function device (see '377 a cash dispenser 44, a receipt dispenser 46 in Fig.1), whereby a user adjacent to the machine causes image input signals to be generated and the voice of the user causes audio input signals to be generated (see '377 ref.16, the abstract, & Fig.1);

- a processor, the processor being in operative connection with the imaging device (inherently in '377 computer 116), the audio input device, and the transaction function device (see '377 Fig.1 refs. 26 (including a speaker is quite obvious with one in the art for controlling audio signals), a video monitor 32 and a cash dispenser 44), the processor also being in operative connection to a data store, wherein the data store includes data corresponding to a user, the user data including identity data (see '377, 4:52-67) corresponding to the user, image data corresponding to an appearance feature of the user (for at least claim 17) (see also '727) (camera 28/customer identification module 36, a check identification and storage module 42, and voice data corresponding to a voice feature of the user (see '848 the abstract; and see '377, 4:38-43, and claims 1-4, 9) (for limitations in at least claim 25);

- a display (for at least claim 4) (see '377 Fig.1 ref.30/32);

- a card reader including in the apparatus for manually actuating input device is quite obvious with

**Lipkin's** disclosure (see '377 Fig.2 refs.76, 78; or ATM card reader);

- an audio output, wherein the output device prompts a user through audio message (see '377 Fig.1 for a handset 26);

- a user data including account data, wherein the machine readable check/card includes account identifying data corresponding to an account associated with the user of the check/card, and wherein the check/card reader provides check/card input signals responsive to reading the check/card, and wherein the processor is operative to resolve the account of the user responsive to the account identifying data (see '377 Figs. 2-3 refs. 68, 70, 156);

- a keypad for inputting a user's code then the processor will make a check (see '377 Fig.3 ref 148, it's quite obvious to place it at a customer station as a means for communication);

- a currency dispenser (see '377 Fig.2 ref.44);

- a document dispenser (see '377 Fig.2 ref.46);

**Lipkin** doesn't expressly teach that: a processor couple to data storage can compare/identify user's data (audio & visual inputs) for a level of correlation to enable transaction function devices.

However, the examiner submits that **Lipkin** teaches an operator is used instead of a processor, and means are provided for enabling the operator to verify the identity of the customer/user (see '377, the abstract).

So (US Pat. 4,990,848) also teaches a DTMF receiver to recognize tones/voices (see '848 the abstract); Atkins ('727 Figs 14B, 14C) teaches similar identifications in transaction procedures that acquiring video prints and voiceprints (in another word: image appearances) to verify/compare for a level of correlation.

The examiner also submits that Lipkin discloses an output device, a display, and a video data storage (see '377 Figs.1,3 refs. 26/28/30/32/156) , and it is well-known that an ATM with user data includes user preference data, and wherein the data store further includes product offering data, wherein the product offering data is representative of products available for purchase, and wherein the processor is operative to select product offerings from the product offering data in the data store responsive to the user preference data corresponding to the user, and to operate the output device to provide outputs corresponding to the selected product offerings.

The examiner also submits that Lipkin discloses a monitoring device (Fig.1, ref.28); it is well-known that this device can be modified to sense a user in a proximity in order to enable/disable a transaction machine; therefore, a method with claimed steps can be derived corresponding to an operation of that device.

Lipkin, Atkins, and So do not disclose about a storage data include specific data.



However, **Batson** ('327) discloses that data may include a profile acquisition routine (see '327 col.11 lines 45-49).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement **Batson's** idea, in financial transaction system of **Lipkin** because this is just about a way of storing specific information in order to minimize retrieval time.

The Official Notice is taken here that other claims' limitations are obvious for one with skills in the art because these features were available and readily to incorporate for verifying or security purposes.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement this pertinent area of application of **Atkins** and **So** 's method/apparatus in the same field of **Lipkin** in financial transaction because these teachings accelerate a movement toward a fully electronic means of identifying user; prior cited teachings offer numerous advantage to users of financial transactions.

#### Conclusion

10. Claims 1-35 are not patentable.

11. Besides cited prior art in the parent invention (US Pat. 6,023,688), these prior art have similar subject matters to this pending application:

- **Russo** et al., (US Pat.6,330,345 - filed on 11/17/1997)  
about automatic adjustment processing for sensor devices.
- **Dickinson** et al., (US Pat.6,049,620 - filed on 5/13/1997)  
about capacitive fingerprint sensor with adjustable gain.
- **Slotznick**, (US Pat.5,983,200 - filed on 10/06/1997) about  
intelligent agent for executing delegated tasks.
- **Lawlor** et al., (US Pat.5,870,724 - filed on 6/06/1995)  
about targeting advertising in a home retail banking  
delivery service.
- **O'Hagan** et al., (US Pat.6,314,406 - filed on 8/29/1997)  
about customer information network.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong H. Nguyen whose telephone number is 703-305-4553. The examiner can normally be reached on Mon.-Fri. from 7:15 AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

**Commissioner of Patents and Trademarks**  
**Washington D.C. 20231**

or faxed to:

**(703)305-7687** [Official communications]

S.N. 09/498,789  
Art Unit 3625

or 703-746-5572 (RightFax)

Hand delivered responses should be brought to Crystal  
Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor  
receptionist.

The receptionist telephone number is (703)308-1113.

*Cuong Nguyen*  
Primary Examiner  
August 07, 2002

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